Remarks

Claims 1 and 3 have been canceled. Claim 4 has been amended to independent form. Claims 4 and 5 remain in this application. Applicants assert that the amendment to claim 4 raises no issue of new matter as the claim was amended to incorporate the elements of the claim from which it originally depended, original claim 1. Entry of the amendments and consideration of the claims and the following discussion are respectfully requested.

Claims 1 and 3 were rejected under 35 U.S.C. § 102(e) as being unpatentable over U.S. Patent #7,345,096. Claims 1 and 3 have been canceled, thereby obviating this rejection. Withdrawal of this rejection in view of the amendments is respectfully requested.

Claims 1, 4 and 5 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent #7,354,920 in view of U.S. Patent #7,345,096. Specifically, the Examiner alleges that although the compound identified in claims 4 and 5 of the present application are not known in the prior art, they and their activity as selective norepinephrine reuptake inhibitors are made obvious by the disclosure of compounds in U.S. Patent #7,354,920. The Examiner then reasons that this information, in combination with the teaching of U.S. Patent #7,345,096 that at least one norepinephrine reuptake inhibitor may be used to treat vasomotor symptoms, renders the presently claimed invention obvious. Applicants respectfully submit that the Examiner's analysis of the present claims in view of U.S. Patent #7,354,920 is incorrect, and that this rejection is improper.

Variable Ar2 in U.S. Patent #7,354,920 ('920 patent) corresponds to the tetrahydropyran-4-yl ring of the compounds referenced in claims 4 and 5 of the present application. This variable in the '920 patent, however, is defined to be an optionally substituted phenyl or 5-6 membered heteroaryl ring. There is no teaching or suggestion that the phenyl or heteroaryl moiety could be replaced with the tetrahydropyran-4-yl moiety required of the compounds of the presently claimed method. Absent this teaching or motivation from the prior art, the Examiner has not met the burden for establishing *prima facie* obviousness. ["In addition to structural similarity between the compounds, a prima facie case of obviousness also requires a showing of "adequate support in the prior art" for the change in structure." *Takeda Chemical Industries Ltd. V. Alphapharm Pty. Ltd.*, 83 USPQ2d 1169, 1174 (Fed. Cir. 2007) citing *In re Grabiak* , 226 USPQ 870 (Fed. Cir. 1985); "Thus, in cases involving new chemical compounds, it remains necessary to identify some reason that would have led a chemist to modify a known compound in a particular manner to establish prima facie obviousness of a new claimed compound." (*Id.*)] The Examiner has simply not met the requirements to establish a case of *prima facie* obviousness in this instance and, therefore, the burden has not shifted to Applicants to rebut the presumption. Withdrawal of this rejection in view of the foregoing argument is respectfully requested.

Finally the Examiner has rejected Claim 1 under 35 U.S.C. § 112, second paragraph, as being indefinite. Claim 1 has been canceled, thereby obviating this rejection. Withdrawal of this rejection in view of the amendment is respectfully requested.

Respectfully submitted,

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